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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,507	04/27/2001	Tatsuya Yoshida	FY.F5404US1C	9059

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EXAMINER

VASUDEVA, AJAY

ART UNIT	PAPER NUMBER
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3617

DATE MAILED: 06/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/844,507

Applicant(s)
Yoshida et al.

Examiner
Ajay Vasudeva

Art Unit
3617



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 22-47 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 22-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/422,214.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 7 6) ☐ Other:

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DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mineo, in view of Ito.

Mineo describes a watercraft [11] having an exhaust system, comprising an exhaust passage extending between an exhaust manifold of the engine and an exhaust discharge port on a first side of the hull tunnel. The exhaust passage has an intermediate portion extending above the top of the hull tunnel, and includes a watertrap device positioned on a second side of the hull tunnel.

Mineo is silent on the provision of a first chamber.

Ito describes the provision of a first chamber [101] branching upwardly from and communicating with an intermediate portion of an exhaust passage, and positioned above the hull tunnel. The first chamber branches out at a position that is downstream from an apex (figure 6) of the intermediate portion (line 20, column 7).

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It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the first chamber in the intermediate portion of the exhaust passage of Mineo, as taught by Ito. Such a modification would have been desirable at the time the invention was made to provide a noise attenuation device for the exhaust passage that does not cause undesirable back pressure, and also traps water when the watercraft overturns.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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4. Claims 22-47 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6,261,140 B1.

All limitations set forth in (a) claims 22-26, (b) claims 27-32, (c) claims 33 and 34, (d) claims 35-38, (e) claims 39 and 40, (f) claims 41-44, and (g) claims 45-47 of the application are fully encompassed in claims (a) claims 1-5, (b) claims 6-11, (c) claims 12 and 13, (d) claims 14-17, (e) claims 18 and 19, (f) claims 20-23, and (g) claims 24-26, respectively, of the U.S. Patent No. 6,261,140 B1.

Claims 1-26 of U.S. Patent No. 6,261,140 set forth an exhaust passage extending between an exhaust manifold and a discharge port, and disclose all limitations being claimed in the claims 22-47, except the exhaust passage extending between the exhaust port and a discharge port.

It is noted that an engine manifold is used to combine several engine ports into a single passage. However, if the engine has only one exhaust port, an engine manifold would not be necessary. Therefore, it would have been obvious for one skilled in the art to remove the exhaust manifold from the at least one exhaust port of the engine of U.S. Patent No. 6,261,140, and attach the exhaust passage directly to the exhaust port. Having such an arrangement would enable one to minimize components used in the exhaust discharge system, and would make its attachment to the engine economical and easier to install.

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Allowable Subject Matter

5. Claims 22-47 would be allowed if the applicant overcomes the double-patenting rejection by filing a terminal disclaimer in compliance with 37 CFR 1.321(c) and by showing the conflicting patent as being commonly owned with this application.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ajay Vasudeva whose telephone number is (703) 306-5992.



S. JOSEPH MORANO
SUPERVISOR, PATENT EXAMINER
TECHNOLOGY CENTER 3600



AV

June 10, 2002